Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claim 1 has been amended to exclude the compounds where (1) R_1 represents a hydrogen atom, A represents a bond or an alkylene chain and R_3 represents a hydrogen atom, and (2) R_1 represents a hydrogen atom, A represents a bond and R_3 represents adamantyl and phenylalkyl. These exclusions are incorporated into claim 1 in response to the rejections of claims 1-13 under 35 U.S.C. §102(b) as being anticipated by Ca 127:81061, Ca 125:301567, Renk et al. and Baumann et al. Adding these exclusions to claim 1 does not constitute new matter or render claim 1 inadequately supported by the disclosure since the specification, having described the whole, necessarily described the part remaining after excising the invention of another. In re Johnson 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977).

Claims 4 and 29 have been amended in response to the rejections of these claims under the second paragraph of 35 U.S.C. §112, thus rendering these rejections moot. The amendment to claim 29 finds support in the preceding language of the same claim. Claims 15, 17 and 19 have been cancelled, thus rendering moot the rejections of these claims under the first and second paragraphs of 35 U.S.C. §112. Additionally, claim 18 has been cancelled, thus rendering moot the rejection of this claim under the second paragraph of 35 U.S.C. §112. New claims 33-35 have been added to the application. Support for these claims can be found in Applicants' specification, at page 23, lines 15-22, and page 20, lines 16-21.

The objection to claims 30-32 as being based on a rejected claim is rendered moot in view of the amendment to claim 29, discussed above.

The patentability of the present invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1-13 under 35 U.S.C. §102(b) as being anticipated by Hecker et al. is respectfully traversed.

It is the position of the Examiner that Hecker et al. disclose the instant compound, 2-pyridinecarboxamide, 3-hydroxy at pages 1-47. However, pages 1-47 covers more than half of the reference and Applicants are unable to find any reference to 2-pyridinecarboxamide, 3-hydroxy

therein. Applicants again request that the Examiner point out the specific portion of the reference where this compound, or any other compound within the scope of the present claims, is disclosed.

The rejection of claims 1-13 under 35 U.S.C. § 102(b) as being anticipated by Ca 127:81061, as well as the rejection of claims 1-13 under 35 U.S.C. §102(b) as being anticipated by Ca 125:301567, and the rejection of claims 1-13 under 35 U.S.C. §102(b) as being anticipated by Baumann et al., have been rendered moot in view of the amendment to claim 1 excluding the compounds of these references.

The rejection of claims 1-13 under 35 U.S.C. §102(b) as being anticipated by Renk et al. is respectfully traversed. The Examiner states that column 8, line 16 of the reference discloses Applicants' claimed compound. However, it is Applicants' understanding that the Examiner meant to refer to column 4, line 70. This compound has been excluded by the amendment to claim 1, and therefore this rejection is rendered moot.

The rejection of claims 1-13 under 35 U.S.C. §102(f) because the applicant did not invent the claimed subject matter, is respectfully traversed. The Examiner refers to Backhaus et al., which was published December 14, 2000, and is based on an application filed in Germany on December 2, 1999. Neither of these dates are prior to the filing date of November 4, 1999 for the PCT application on which the present U.S. application is based. Therefore, the Backhaus et al. reference is not available as prior art.

The rejection of claims 1-13 under 35 U.S.C. §102(g) as being anticipated by Backhaus et al. is respectfully traversed. The Examiner does not specify whether the rejection is under 35 U.S.C. §102(g)(1) or 35 U.S.C. §102(g)(2). Since the application is not in interference, Applicants assume the Examiner intends to reject the claims under §102(g)(2). However, §102(g)(2) is not appropriate because the Examiner has offered no evidence that the present invention was invented by another in the U.S., as required by 35 U.S.C. §102(g)(2). Applicants note that the Backhaus et al. reference is a German patent based on a German application.

For these reasons, the invention of claims 1-13 is clearly patentable over Backhaus et al.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

Keiichi IMAMURA et al.

By: _____

Amy E. Pulliam
Registration No. 55,965
Agent for Applicants

MRD/AP/pth
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
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